

Our Docket No.: 01-00009
Inventors: Stuelpnagel et al.
Serial No.: 10/767,249
Filing date: January 28, 2004

REMARKS

By the present communication claim 29 has been amended and new claims 55 is added. Support for the amendments to claim 29 can be found in the specification, for example, at Figure 1A, page 6, lines 25-35 and page 34, lines 21-23. Support for new claim 55 can be found, for example, at page 13, lines 4-14. Accordingly, the amendments do not raise any issues of new matter. Therefore, entry of the amendments is respectfully requested. Following entry of the amendments claims 29-55 will be under examination.

Status of Related Case

There is currently one U.S. patent application under prosecution that is priority-related to the instant application. The related application is U.S. Ser. No. 10/767,476 and response to final Office Action was filed with an RCE on October 29, 2007.

Rejections Under 35 U.S.C. § 102

Claims 29-30, 33-34, 38-39, 40-45, and 48-52 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Nova et al. (US 6,340,588).

Applicants respectfully traverse the rejection. Nevertheless, in order to further prosecution of this application the claims have been amended to require that each array location of the second substrate is "on a projection" and that the projections are dipped "into the assay wells such that each array location of the second substrate contacts sample solution in a different well of the first substrate." Nova et al. does not describe a method of detecting the presence or absence of a plurality of different target analytes using a first and second substrate having the features required by the claims as amended. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

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Rejections Under 35 U.S.C. § 103

Claims 31-32, 35-37, and 45-47 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Nova et al. (US 6,340,588) in view of Fodor et al. (US 5,800,922). In making the rejection, the Office Action relies upon the characterization of Nova et al. set forth in the novelty rejection. The Office Action points out that Nova et al. does not describe several of the elements recited in claims 31-32, 35-37, and 45-47. The Office Action alleges that Fodor et al. describes the missing elements.

Applicants respectfully traverse the rejection. Nevertheless, in order to further prosecution of this application the claims have been amended to require that each array location of the second substrate is “on a projection” and that the projections are dipped “into the assay wells such that each array location of the second substrate contacts sample solution in a different well of the first substrate.” Nova et al. taken alone or in combination with Fodor et al. does not teach or suggest a method of detecting the presence or absence of a plurality of different target analytes using a first and second substrate having the features required by the claims as amended. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

Double Patenting

Claims 29-51 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly unpatentable over claims 1-5 and 9 of US 6,858,394.

Applicants respectfully traverse the rejection. The rejection is deficient because the Office Action provides no rationale for alleged obviousness. Rather, the Office Action merely asserts that the “conflicting claims . . . are not patentably distinct from each other because the patent and instant claims are drawn to a genus:species relationship.” Applicants will assume, without necessarily conceding, that the Examiner is alleging that the instant claims are species of the patented claims and not *vice versa* although this is not clear from the rejection as presented. The Office Action appears to be relying on a species being *per se* obvious over a genus. However, as pointed out in the MPEP at 2144.08(II):

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Use of *per se* rules by Office personnel is improper for determining whether claimed subject matter would have been obvious under 35 U.S.C. 103. See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995); *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994). The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994)

Absent some rationale for a finding that a particular species is obvious over a particular genus, a *prima facie* case has not been established. Therefore, claims 29-51 are not obvious over claims 1-5 and 9 of US 6,858,394. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 29-51 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly unpatentable over claims 6-24 and 31-58 of US 7,060,431.

Applicants respectfully traverse the rejection. Much like the previous obviousness-type double patenting rejection, the Office Action alleges that the "patent and instant claims are drawn to a genus:species relationship." Applicants are again placed in a position to assume, but do not necessarily concede, that the instant claims are being treated as a species of the patented claims. The Office Action appears to allege that the claims by reciting a "dipping" action are species of the patented claims which recite a "contacting" action. In setting forth the rejection the Office Action relies on the description of dipping at column 18 of the '431 specification. However, such reliance on the specification of the patent is impermissible in the context of alleged double patenting.

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

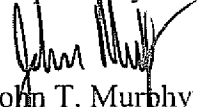
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See MPEP 804(II)(B)(1). Therefore, the Office Action has provided no permissible rationale for the rejection and has not satisfied the burden of establishing a *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

In light of the Amendments and Remarks herein, Applicant submits that the claims are in condition for allowance and respectfully request a notice to this effect. The Examiner is invited to call the undersigned agent should there be any questions.

Respectfully submitted,


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